What is a Brand?
• Your brand is your organization’s relationship to the public – communication of identity and credibility
• Your brand is what the public instantly understands about a product or service once it is identified with your organization
• A brand is most often communicated through visual identifiers including your name, logo, tagline or slogan, being associated with a product or service

Why is a Brand Important for Charities?
• The business concepts or purposes of branding are equally applicable to the charitable sector
  – To identify charity as provider of goods and services
  – To distinguish one charity from another
  – To increase goodwill and donor base
  – To create equity and brand value, which can lead to lucrative licensing opportunities
3) What Happens to a Poorly Managed Brand?

- Public lacks awareness or interest in the organization
- Slower growth for organization
- Public finds it difficult to contact you
- Unable to police imitators and imitators
- Can lose out on valuable IP assets
  - Domain names
  - Trade-marks
- Can lose existing IP – including name of organization

4) How can We Build and Protect Our Brand?

- For most charities and other organizations, your brand begins with your name
- Your brand is communicated to the public every time that you identify your charity to the public
- Canadian and international laws recognize certain aspects of your brand as protectable forms of intellectual property
- Important identifying aspects, such as a name, logo or slogan can be protected according to the law of Trade-marks
5) What is a Trade-mark?

- A trade-mark is any mark used for the purpose of distinguishing wares (products) and services manufactured, sold, leased, hired or performed from those of others.
- A trade-marks can consist of:
  - A single word, “iPod”
  - A combination of words, “Red Cross”
  - A logo or symbol, the big “M” in McDonalds
  - A slogan, “I’m Lovin’ it”
  - A certain package or container “Toblerone”
  - Even a sound “NBC chimes”

6) Examples of Trade-marks for Charities and NFP’s

- Trade-marks are not only for businesses. Trade-marks are also used in the non-profit sector, for example:
  - Corporate names: “Heart and Stroke Foundation of Canada”
  - Operating names: “Heart and Stroke Foundation”
  - Logos: “The Panda from World Wildlife Fund”
  - Acronyms: “WWF”
  - Slogans: “Run for the Cure”
- Most likely, examples would also include your organization’s name, logos and slogans.
7) What is the Legal Impact of Our Trade-marks?
   - Your brand and identity are subject to trade-mark law
   - Therefore, a charity, like any other business that has trade-marks, has legal rights which enable it to prevent other organizations from using infringing trade-marks
   - Accordingly, a charity that is using a trade-mark is also subject to the legal rights of other organizations which would allow them to prevent the charity from using an infringing trade-mark

8) Infringement and Confusion
   - The key question to determine if there is a possible infringement is whether a trade-mark is causing or is likely to cause confusion with an existing trade-mark
   - A trade-mark is not confusing if it distinguishes one’s wares or services from another’s
   - A trade-mark causes confusion with another trade-mark if a consumer who sees both trade-marks would infer that the source of the wares or services associated with those trade-marks is the same

B. PROTECTING YOUR BRAND & TRADE-MARKS
1) How do we Protect our Trade-marks?
   1. Search
   2. Register
   3. Control
C. THE SEARCH
1) What is the Purpose of a Trade-mark Search?
   • Search for registered trade-marks or other possible obstacles to the registration of your trade-mark
   • Discover possible infringement of your trade-mark by another organization
   • Determine availability and discover whether there are users of marks similar to or confusing with yours

2) First Users and Common Law Rights
   • At common law and under the Trade-marks Act, the first user of a trade-mark is the party entitled to use and to register that trade-mark
   • Trade-mark rights are acquired through use
   • The common law provides protection to restrain a competitor from passing off its goods or services under the trade-mark of another
   • The cause of action at common law is called a “passing off” action

• To prove “passing off” the plaintiff must show:
  – Existence of goodwill
  – Deception / Misrepresentation
  – Damages
• Protects the public and the trade-mark owner
• Common law protection of a trade-mark does not require that the trade-mark be registered, but trade-mark rights at common law are far more difficult to enforce and remedies are limited
• Users of unregistered marks therefore do have rights
3) Evaluating Search Results
- Options available if the Search reveals a mark which could be considered to be confusing with yours:
  - Investigate further to determine if there is no conflict with rights of trade-mark owner
  - If there is a likelihood of confusion:
    - Challenge the rights of the trade-mark owner
    - Avoid confusion by rebranding
- Problems are easiest to deal with if they are discovered early, so conduct searches before your new brand or trade-mark is made public.

4) Consequences for Failure to Search
- Masterpiece Inc. v. Alavida Lifestyles Inc.
- Research in Motion
- Amazon.com

D. PROTECTION THROUGH REGISTRATION
1) Registered vs. Common Law Protection
- Registration is the confirmation of common law rights acquired through use
- Sometimes referred to as “perfecting” rights or “crystallization” of rights
- Registration exists because of the Trade-marks Act
- The statutory law affirms the common law right and adds to it - significantly enhancing rights for a trade-mark that is registered.
2) The Advantages of Trade-mark Registration

- Trade-mark registration provides a presumption of a valid trade-mark.
- Trade-mark registration provides the exclusive right to use the trade-mark with respect to its goods or services.
- The registration is effective throughout Canada.
- The registration gives public notice of the trade-mark.
- A trade-mark registration can become virtually incontestable in some situations.

3) The Race to Register

- The first user is technically entitled, but the first party to file gains a significant advantage in securing rights.
- The first person to register may effectively “usurp” the rights of the first user.
- Can challenge application through opposition (if you are aware of it).
- Once registered, can only attack validity in Federal Court.
- After five years, must prove registrant had knowledge of your earlier use (bad faith requirement).

4) Filing and Prosecuting Trade-mark Applications

- What does a trade-mark application cover?
  - A separate trade-mark application must be filed for each trade-mark.
  - However, one trade-mark application can cover both wares and services.
  - There is no limit to the number of wares and services that can be included in one application.
- A trade-mark application can be based on either existing use or proposed use in Canada.
5) Consequences of Failure to Register
- Masterpiece Inc. v. Alavida Lifestyles Inc.
- Apple iPad
- “Movember”

6) How do We Protect Our Trade-marks?
- Search
  - Searching early allows you to avoid “stepping on toes” of existing users
- Register
  - Registering immediately allows you to protect against later users or “usurping” registrants

E. CONTROLLING TRADE-MARK USE
1) By the Owner: Consistency and Frequency
- Use it or Lose it
- Failure to use is grounds for invalidating registration and loss of common law rights
- Register what you use and use what you register
- Implement brand standards and use consistently
2) By Third Parties: Licensing

- The Trade-marks Act deems the use of the trade-mark of a licensee to be use of the owner
- There must be a licensing arrangement
- The license arrangement should be in writing
- License must be granted by the trade-mark owner
- Owner must maintain direct or indirect control of the character, quality and use of the trade-mark in association with wares and services

3) When is Licensing Relevant to Consider?

- When a charity sets up local chapters and wishes to maintain ownership and control of its trade-marks
- When a charity permits other organizations to use its trade-mark as evidence of membership or to show that standards are being maintained
- When a charity permits its trade-mark to be used in conjunction with an event conducted by others on behalf of the charity
- When a charity is planning to enter into a sponsorship arrangement
### 4) General Licensing Considerations
- Scope of license in relation to use, time and geographic territory
- Quality control
- Rights of assignment and sub-license
- Indemnification considerations
- Maintaining confidentiality
- Termination of license agreement
- Effect of termination of agreement

### 5) Policing Unauthorized Use
- Ensure proper monitoring and enforcement of trade-marks
- Monitor infringement by other competing trade-marks, both registered and unregistered
- Protection under the *Trade-marks Act* to enforce rights
- Be pro-active in stopping infringement of a trade-mark, otherwise the trade-mark may be lost by default

### 6) Consequences of Failure to Control
- Section 45
- Loss of distinctiveness
- Ownership disputes - Caribana
7) How do We Protect Our Trade-marks?
   • Search
     – Searching early allows you to avoid “stepping on toes” of earlier users
   • Register
     – Registering immediately allows you to protect against later users or “usurping” registrants
   • Control
     – Use it or lose it
     – Failure to control now could mean loss of rights later

F. OTHER CONSIDERATIONS
1) Take a Portfolio Management Approach
   • Ensure parallel registrations are also secured
     – Corporate name
     – Operating names
     – Domain Names
     – Official Marks and Registered Trade-marks
   • Ensure the charity owns copyright in design marks
   • Register in all applicable jurisdictions

2) International Considerations
   • Trade-marks are governed independently by every country
   • International treaties to promote consistency
   • Registration in Canada only protects the mark in Canada
   • Co-ordinate launch of a new brand in order to maintain control at early stages
   • 6-month priority period allows you to claim filing date of first trade-mark application for subsequent foreign applications
3) Trade-marks and Domain Names

- Trade-mark registration can also assist in protecting a domain name on the internet from cyber squatting.
- But domain names are registered on a first-come first-served basis, and many parties may have a legitimate interest in the same domain name.
- Trade-mark will not always trump an infringing domain name registration.
- Be proactive and register domain names as early as possible.

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